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EXAMINER

INGVOLDSTAD, BENNETT

ART UNIT

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2623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                       |                                    |  |
|------------------------------|---------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/610,938  | <b>Applicant(s)</b><br>GRAY ET AL. |  |
|                              | <b>Examiner</b><br>BENNETT INGOLDSTAD | <b>Art Unit</b><br>2623            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 9-13, 18-22, 29-34, 39-43, 49-53 and 58-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-17, 23-28, 35-38, 44-48 and 54-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group 1, consisting of claims 1-8, 14-17, 23-28, 35-38, 44-48, and 54-57 in the reply filed on 4 June 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Response to Arguments***

2. Applicant's arguments filed 17 March 2008 have been fully considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-8, 14-17, 23-28, 35-38, 44-48, and 54-57 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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5. Independent claims 1, 23, and 44 have been amended to require determining whether to inform one or more users of an interactive television service of available content during an advertisement being viewed by the one or more users, “the determining independent of any request by the one or more users for the available content, but based at least in part on a search for available content having subject matter related to subject matter of the advertisement being viewed by the one or more users when the search is conducted”. The determining is done by an interactive television service data center.

6. The specification provides no support for the interactive television service provider searching for content with subject matter related to an advertisement being viewed when the search is conducted. In particular, no search of any kind is disclosed. Although the available content is disclosed as having related subject matter to an advertisement (Specification pg. 11, l. 7-12), no disclosure of who searches and finds the available content is present.

7. Even if, arguendo, a search by the interactive television service provider is implied or may be assumed based on Applicant's disclosure, no further support for the search being conducted while the advertisement is being viewed is present. Rather, the available content hot key signals are, at least in one embodiment, generated by an operations team during a preparation and scheduling routine. Specification pg. 15, lines 12-19. No temporal relationship between the preparation and scheduling routine and an advertisement being viewed is presented.

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8. Therefore independent claims 1, 23, and 44 fail to comply with the written description requirement.

9. Dependent claims 2-8, 24-28, and 45-48 are rejected as depending on claims that fail to comply with the written description requirement.

10. Independent claims 14, 35, and 54 have been amended to require "responsive to receiving an indication that the hot key is accepted by the user, display[ing] on the screen at least part of the message field; and responsive to receiving an indication of acceptance by the user after the at least part of the message field has been displayed, redirect[ing] the user device to the available content."

11. The specification does not provide support for such a three-step process of displaying and accepting a hot key, displaying and accepting part of a message, and finally displaying the available content. Rather, the message portion is disclosed in one embodiment as an alternative to the hot key icon. Specification pg. 27, lines 3-7. In another embodiment, the message is displayed simultaneously with the hot key as a supplement to assist the user in deciding whether to accept the hot key. Specification pg. 22, line 20 - pg. 23, line 2. In neither embodiment can the message be displayed after the hot key has been accepted.

12. Therefore independent claims 14, 35, and 54 fail to comply with the written description requirement.

13. Dependent claims 15-17, 36-38, and 55-57 are rejected as depending on claims that fail to comply with the written description requirement.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-8, 23-28, and 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis (US 2007/0124763) in view of Kunkel (US 7100183) and Omoigui (US 2005/0086688).

Regarding claim 1, Ellis discloses a method comprising:

at an interactive television service data center, determining whether to inform one or more users of an interactive television service of available content during [a program] being viewed by the one or more users, the determining independent of any request by the one or more users for the available content... (messages promoting alternate content are sent based on a decision regarding whether a new program is expected to be enjoyed [0073]);

responsive to determining to inform the one or more users of the available content [...], generating a hot key signal indicating availability and a location of the alternate content (the message is generated before being sent [0073]); and

inserting the hot key signal into a content signal transmitted to the one or more users from an interactive television service provider via a network with

which the one or more users and the interactive television service provider are connected (the messages are delivered through the television system [0074])

Ellis does not specifically disclose that the message is delivered during an advertisement.

Kunkel discloses a method of informing a user of the availability of alternate content during an advertisement (additional information about advertised programs, products, or services [col. 4 line 47 – col 5 line 6]).

It would have been obvious to modify the method disclosed by Ellis with the teaching of Kunkel for the purpose of allowing a user to view recommendations for alternate content based not only on a particular television show [Ellis 0073], but also on a particular advertisement [Kunkel col 4 47-50].

Ellis in view of Kunkel does not further disclose the determination based at least in part on a search for available content having subject matter related to subject matter of the advertisement being viewed by the one or more users when the search is conducted.

Omoigui discloses a method of determining whether to inform a user of available content, wherein the determination is based on a search for available content having subject matter related to subject matter of the content being viewed by the user when the search is conducted (search for related content may be conducted in parallel with a monitoring of the current subject matter being viewed by the user [0098] [Fig 12]).

It would have been obvious to modify the determining method of Ellis in view of Kunkel to be based on subject matter being viewed at the time of the search, as disclosed by Omoigui, for the purpose of providing available content that is closely correlated with the subject matter currently being viewed by the user [Omoigui 0098].

Regarding claim 23, Ellis discloses a system comprising:

a content reception (Distribution Facility receives content from Program Guide Data Source [Fig. 1]) , distribution (Distribution Facility [Fig. 1]) , and switching portion (Communications Network [Fig. 1]) connected with one or more content providers (Program Guide Data Source [Fig. 1]) to receive and redistribute interactive television (TV) content

a head-end transport portion connected with the content reception, distribution, and switching portion to encode, multiplex and transmit content signals from the content reception, distribution, and switching portion over a network (Fig. 1); and

a hot key generation portion to determine whether to inform one or more users of an interactive television service of available content, the determining independent of any request by the one or more users for the available content... (messages promoting alternate content are sent based on a decision regarding whether a new program is expected to be enjoyed [0073]),



responsive to determining to inform the one or more users of the available content, and generate a hot key signal indicating availability of the available content [0073-0074]

Ellis does not specifically disclose that the message is delivered during an advertisement.

Kunkel discloses a method of informing a user of the availability of alternate content during an advertisement (additional information about advertised programs, products, or services [col. 4 line 47 – col 5 line 6])

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method disclosed by Ellis with the teaching of Kunkel for the purpose of allowing a user to view recommendations for alternate content based not only on a particular television show [Ellis 0073], but also on a particular advertisement [Kunkel col 4 47-50].

Omoigui discloses a method of determining whether to inform a user of available content, wherein the determination is based on a search for available content having subject matter related to subject matter of the content being viewed by the user when the search is conducted (search for related content may be conducted in parallel with a monitoring of the current subject matter being viewed by the user [0098] [Fig 12]).

It would have been obvious to modify the determining method of Ellis in view of Kunkel to be based on subject matter being viewed at the time of the search, as disclosed by Omoigui, for the purpose of providing available content that is

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closely correlated with the subject matter currently being viewed by the user [Omoigui 0098].

Regarding claim 44, Ellis discloses a machine readable medium having stored thereon a series of instructions (messages can be created automatically so a processor is used which implies a medium with instructions), the instruction, when executed by a processor, cause the processor to:

determine whether to inform one or more users of an interactive television service of available content, the determining independent of any request by the one or more users for the available content... (messages promoting alternate content are sent based on a decision regarding whether a new program is expected to be enjoyed [0073]);

responsive to determining to inform the one or more users of the available content, generate a hot key signal indicating availability of the available content (reminder messages [0070]); and

insert the hot key signal into a content signal transmitted to the one or more users from an interactive television service provider via a network with which the one or more users and the interactive television service provider are connected (the messages are delivered through the television system [0074])

Ellis does not specifically disclose that the message is delivered during an advertisement.

Kunkel discloses a method of informing a user of the availability of alternate content during an advertisement (additional information about advertised programs, products, or services [col. 4 line 47 – col 5 line 6])

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method disclosed by Ellis with the teaching of Kunkel for the purpose of allowing a user to view recommendations for alternate content based not only on a particular television show [Ellis 0073], but also on a particular advertisement [Kunkel col 4 47-50].

Omoigui discloses a method of determining whether to inform a user of available content, wherein the determination is based on a search for available content having subject matter related to subject matter of the content being viewed by the user when the search is conducted (search for related content may be conducted in parallel with a monitoring of the current subject matter being viewed by the user [0098] [Fig 12]).

It would have been obvious to modify the determining method of Ellis in view of Kunkel to be based on subject matter being viewed at the time of the search, as disclosed by Omoigui, for the purpose of providing available content that is closely correlated with the subject matter currently being viewed by the user [Omoigui 0098].

Regarding claims 2, 25, and 45, depending on claims 1, 23, and 44, Ellis in view of Kunkel further discloses:

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wherein determining whether to inform one or more users of an interactive television service of available content during an advertisement is based on information supplied by a content provider (the available content is related to advertisements [Kunkel col 4 47-50], which are supplied by content providers)

Regarding claim 3, depending on claim 2, Ellis in view of Kunkel further discloses:

wherein the content provider has paid the interactive television service provider to generate and transmit the hot key (the hot key comprises an advertisement [Kunkel col 4 33-42], and advertisements are paid for by sponsors)

Regarding claims 4, 26, and 46, depending on claims 1, 23, and 44, Ellis in view of Kunkel further discloses:

wherein determining whether to inform one or more users of an interactive television service of available content during an advertisement is based on information generated by the interactive television service provider (based on e.g. whether or not a user has subscribed to a channel [Ellis 0013])

Regarding claim 5, depending on claim 1, Ellis further discloses:

wherein the one or more users of the interactive television service have paid the interactive television service provider to receive the hot key signal (the user

can pay for a PPV program which is used as a criteria for determining whether to send a message [0013])

Regarding claim 6, depending on claim 1, Ellis further discloses:

wherein the one or more users of the interactive television service have not paid the interactive television service provider to be excluded from receiving the hot key signal (if the user does not pay for a PPV program, which is used as a criteria for determining whether to send a message, the message will not be received [0013])

Regarding claims 7, 27, and 47, depending on claims 1, 23, and 44, Ellis further discloses:

wherein the hot key signal comprises an Internet Protocol (IP) data packet (messages can be distributed through the Internet [claim 2]), the IP data packet having a header portion and a body portion, the body portion having a data field indicating a location of the alternate content (alternate content location is indicated in e.g. reminder messages [fig. 7], and IP packet payload data is contained in the body portion)

Regarding claims 8, 28, and 48, depending on claims 1, 23, and 44, Ellis in view of Kunkel further discloses:

wherein the available content is related to content currently being viewed by the one or more users (additional information is based on the advertised program product or service [Kunkel col 4 47-50]).

Regarding claim 24, depending on claim 23, Ellis further discloses:

wherein the head-end transport portion receives the hot key signal from the hot key generation portion, and multiplexes the hot key signal with the content signal (see Fig. 1 and description of path 26 in [0074]).

16. Claims 14-17, 35-38, and 54-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis (US 2007/0124763) in view of Kelly (US 2006/0010476).

Regarding claim 14, Ellis discloses a method comprising:

receiving at a user device a hot key signal from an interactive television provider's network, [...] the hot key signal containing a message field and indicating availability of available content (a reminder message [fig. 7]);

determining, at the user device, independent of any request by a user of the user device for the available content, [...] whether the hot key signal is relevant to the user (STB uses targeting criteria to determine relevancy [0018], messages can be unsolicited [0073]) ;

displaying on the screen at least part of the message field [Fig 7].

Ellis does not further disclose that the hot key signal is related to an advertisement being viewed by the user of the user device. Nor does Ellis disclose displaying on a screen a hot key, and then displaying the at least part of the message field after the hot key has been accepted. Nor does Ellis disclose responsive to receiving an indication of acceptance of the message, redirecting the user to the available content.

Kelly discloses that an available content may be related to an advertisement being viewed (by virtue of being presented at the beginning of an advertisement [0030], or because the additional content makes the advertisement content more attractive [0032]). The available content may be indicated by a hot key icon [0030], and selecting a control may redirect the user to the available content [0030-0031].

Therefore it would have been obvious to modify the method of Ellis so that the available content is related to an advertisement, for the purpose of making advertisement content more attractive to users [Kelly 0032]. Further, it would have been obvious to modify the method to indicate the presence of available content using a hot key icon, because such an icon was known as a type of control for selecting alternate content [Kelly 0030]. Further, it would have been obvious to redirect the user to the available content after selection of the message, for the purpose of viewing the alternate content along with the advertisement [Kelly 0030].

Regarding claim 35, Ellis discloses a system comprising:

a tuner, receiver, and demodulator portion and a demultiplexor portion to receive a hot key signal [...] (STB receives a message from television provider [0017]), the hot key signal containing a message field [Fig 7], and indicating availability of available content (a reminder message [fig. 7]);

a processor to:

determine whether the hot key signal is relevant to a user of an interactive television (TV) provider, the determining independent of any request by the user for the available content (STB uses targeting criteria to determine relevancy [0018], messages can be unsolicited [0073]);

display on the screen at least part of the message field [Fig 7].

Ellis does not further disclose that the hot key signal is related to an advertisement being viewed by the user of the user device. Nor does Ellis disclose displaying on a screen a hot key, and then displaying the at least part of the message field after the hot key has been accepted. Nor does Ellis disclose responsive to receiving an indication of acceptance of the message, redirecting the user to the available content.

Kelly discloses that an available content may be related to an advertisement being viewed (by virtue of being presented at the beginning of an advertisement [0030], or because the additional content makes the advertisement content more attractive [0032]). The available content may be indicated by a hot key icon



[0030], and selecting a control may redirect the user to the available content [0030-0031].

Therefore it would have been obvious to modify the method of Ellis so that the available content is related to an advertisement, for the purpose of making advertisement content more attractive to users [Kelly 0032]. Further, it would have been obvious to modify the method to indicate the presence of available content using a hot key icon, because such an icon was known as a type of control for selecting alternate content [Kelly 0030]. Further, it would have been obvious to redirect the user to the available content after selection of the message, for the purpose of viewing the alternate content along with the advertisement [Kelly 0030].

Regarding claim 54, Ellis discloses a machine readable medium having stored thereon a series of instructions (STB uses a processor [0048] which implies a machine readable medium with instructions), the instruction, when executed by a processor, cause the processor to:

receive a hot key signal [...], the hot key signal containing a message field [Fig 7], and indicating availability of available content (reminder message [0070]);

determine whether the hot key signal is relevant to a user of an interactive television (TV) provider independent of any request by the user for the available content (STB uses targeting criteria to determine relevancy [0018], messages can be unsolicited [0073]).

display on the screen at least part of the message field [Fig 7].

Ellis does not further disclose that the hot key signal is related to an advertisement being viewed by the user of the user device. Nor does Ellis disclose displaying on a screen a hot key, and then displaying the at least part of the message field after the hot key has been accepted. Nor does Ellis disclose responsive to receiving an indication of acceptance of the message, redirecting the user to the available content.

Kelly discloses that an available content may be related to an advertisement being viewed (by virtue of being presented at the beginning of an advertisement [0030], or because the additional content makes the advertisement content more attractive [0032]). The available content may be indicated by a hot key icon [0030], and selecting a control may redirect the user to the available content [0030-0031].

Therefore it would have been obvious to modify the method of Ellis so that the available content is related to an advertisement, for the purpose of making advertisement content more attractive to users [Kelly 0032]. Further, it would have been obvious to modify the method to indicate the presence of available content using a hot key icon, because such an icon was known as a type of control for selecting alternate content [Kelly 0030]. Further, it would have been obvious to redirect the user to the available content after selection of the message, for the purpose of viewing the alternate content along with the advertisement [Kelly 0030].

Regarding claims 15, 36, and 55, depending on claims 14, 35, and 54, Ellis further discloses:

wherein the hot key signal comprises an Internet Protocol (IP) data packet (messages can be distributed through the Internet [claim 2]), the Internet Protocol data packet having a header portion and a body portion, the body portion having a data field indicating a location of the available content (alternate content location is indicated in e.g. reminder messages [fig. 7], and IP packet payload data is contained in the body portion).

Regarding claims 16, 37, and 56, depending on claims 14, 35, and 54, Ellis further discloses:

wherein determining whether the hot key signal is relevant to the user comprises determining whether a destination address for the hot key signal is an address of the user device (the signal can be sent over IP [claim 15 rejection] – IP packets contain a destination address).

Regarding claims 17, 38, and 57, depending on claims 16, 37, and 54, Ellis in view of Kelly further discloses:

wherein determining whether the hot key signal is relevant to the user further comprises determining whether the available content is related to content in which the advertisement is presented [Kelly 0030, 0031].

***Conclusion***

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENNETT INGOLDSTAD whose telephone number is (571)270-3431. The examiner can normally be reached on M-Th 8-6:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bennett Ingvaldstad/  
Examiner, Art Unit 2623

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2623